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"PATENT"

AMENDMENT TRANSMITTAL FORM

In re application of: Margaret M. Wu, et al.
U. S. Serial No.: 10/663,567 [810034]
Filed: September 16, 2003
For: NOVEL SYNTHETIC LUBRICANT
COMPOSITIONS AND PROCESS

) Before the Examiner
) Rip A. Lee
)
) Confirmation Number: 2983
)
) Group Art Unit: 1713
) Family Number: P2002J097 US2

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

CERTIFICATION OF FACSIMILE TRANSMISSION

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Susan Fleming

Signature

October 3, 2005

Date

Transmittal herewith is an amendment/response in the above-identified application.

Petition for extension of time pursuant to 37 CFR 1.136 and 1.137 is hereby made, if and to the extent, required. The fee for this extension of time is calculated to be \$_____ to extend the time for filing this response until _____.

The fee for any changes in number of claims has been calculated as shown below.

CLAIMS AS AMENDED						
(1)	(2) Claims Remaining After Amendment	(3)	(4) Highest Number Previously Paid For	(5) Present Extra	(6) Rate	(7)
Total Claims	*	Minus	**		x 50.00	
Indep. Claims	*	Minus	***		x 200.00	
MULTIPLE DEPENDENT CLAIM FEE					\$ 360.00	
					FEE FOR CLAIM CHANGES	

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The total fee for this Amendment, including claim changes and any extension of time is calculated to be \$ 0.

☒ Charge \$ 0 to DEPOSIT ACCOUNT NO. 05-1330.

☒ The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 and 1.17 which may be required by this paper, or credit any overpayment, to DEPOSIT ACCOUNT NO. 05-1330. A duplicate copy of this Form is enclosed.

10/3/05
DATE OF SIGNATURE

Post Office Address: [to which correspondence is to be sent]
ExxonMobil Research and Engineering Company
P. O. Box 900
Annandale, New Jersey 08801-0900



27810

PATENT TRADEMARK OFFICE

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☒ Pursuant to 37 CFR 1.34(a)

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Margaret M. Wu, et al.

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Sir:

This correspondence is in response to the above-referenced office action rejection mailed August 2, 2005. Please consider the following arguments and remove the rejection.

35 USC § 102 REJECTION

Examiner rejected claim 1 as being anticipated by U.S. Patent No. 6,660,894 ("Wu, et al.").

MPEP §2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co., of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

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Susan Fleming

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U.S. Serial No. 10/663,567

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Reply to Office Action of: August 2, 2005

Family Number: P2002J097 US2

Contrary to the Examiner's statement that all elements and limitations are disclosed in the Wu, et al. reference elements (b) and (c) are not so the rejection is unsupported by the art and should be withdrawn. Step (c) requires "hydrogenating the isomerized liquid copolymer." Since the liquid copolymer is isomerized in step (b), the hydrogenation step occurs after the isomerization step.

Examiner is wrong that Wu, et al. discloses an embodiment where isomerization is carried out before hydrogenation. Examiner cites column 5, lines 1-12 to argue, "It can be seen that Wu, et al. teaches an oligomerization step carried out in substantial absence of hydrogen. It is clear from the reference that the cited paragraph is carried out only after hydrogenation. In fact, the description and examples throughout the specification only teach either isomerization followed by hydrogenation or hydrogenation and isomerization being performed together. In all of the examples, hydrogen is co-injected with the oligomer feed, and not removed until completion of the hydrogenation/isomerization process. The reference does not disclose isomerization followed by hydrogenation either explicitly or inherently. An example of the hydrogenation first and then isomerization is in column 5 lines 24-32 of Wu, et al. stating, "... the oligomerization product contacts the first solid material, facilitating hydrogenation, prior to contacting the second material, facilitating isomerization and selective/minor cracking." Lines 48-52 in column 5 of Wu *et al.* disclose the hydrogenation and isomerization taken place in the same reactor. Isomerizing before hydrogenating is not explicitly disclosed in Wu, et al. reference. Since the reference discloses two different procedures it cannot inherently disclose isomerization followed by hydrogenation.

The Wu, et al., reference does not disclose isomerizing the liquid polymer in the substantial absence of molecular hydrogen as claimed in step (b). As stated above, a claim is anticipated only if each and every element set forth in the claims is found, either expressly or inherently described, in a single art reference. The Wu, et al. reference does not either expressly or inherently describe a process where a liquid polymer is isomerized in the absence of hydrogen.

As established above, Wu, et al. only discloses a process where either the isomerization step either occurs after or during the hydrogenation step. Examiner admits in the office action "... the hydrogenation step where as the name implies, hydrogen is required (col. 4, lines 52-67)." Since in Wu, et al., isomerization occurs during or after hydrogenation and hydrogenation requires hydrogen, the isomerization **MUST** occur in the presence of hydrogen unless hydrogen is removed. Wu et al., does not disclose removing hydrogen as Examiner argues in the office reaction, "the presence of hydrogen does not affect isomerization, and thus, the hydrogen is not removed *via* another outlet." Applicants agree with Examiner that the hydrogen is not removed in Wu, et al., but strongly disagree that hydrogen does not affect isomerization.

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If hydrogen does not affect isomerization as Examiner claims, the hydrogenation and isomerization could be performed in any order. Applicants submit that if molecular hydrogen is present with the first catalyst or with the combination of the first and second catalyst the efficiency for isomerization would be extremely low and would promote undesirable side reactions such as cracking to waste products.

Applicants have clearly shown that the Wu, et al, reference cannot disclose steps (b) and (c) in claim 1. It appears the argument that the isomerization in Wu takes place in the presence of molecular hydrogen and hydrogen has no effect on the subsequent isomerization step based upon personal information of the Examiner and not the Wu reference itself. If the rejection is maintained, the Applicants request an Examiner's affidavit under 37 CFR 1.104(d)(2). Under this Section, "when a rejection is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons."

Based on the arguments above that Wu, et al. does not disclose the limitations in claim 1, Examiner is respectfully requested to remove the rejection and allow claim 1.

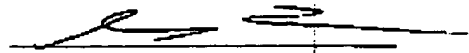
35 USC § 103 REJECTION

Examiner rejected claims 2-9 as being unpatentable by Wu, et al. in view of U.S. Patent No. 6,124,513 (Heilman, et al.). For the reasons discussed above Applicants have demonstrated that claim 1 is allowable. Claims 2 through 9 all depend on claim 1 and claims that depend on allowable claims contain the same allowable subject matter. Therefore, Examiner is respectfully requested to reconsider and remove the rejection of claims 2-9.

CONCLUSION

The application is now in condition for allowance. Applicant respectfully requests the Examiner reconsider the rejection of the claims in view of the amendments.

Respectfully submitted,


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October 3, 2005

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